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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,517	10/25/2001	Kevin Tabor	OIC-PT010	3249

3624 7590 03/31/2004

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EXAMINER

HOFFMANN, JOHN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,517

Applicant(s)

TABOR, KEVIN

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 21-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Amendment

The amendment filed 02 January 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The deletion on page 5.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Page 5, 3rd line from the bottom refers to 17 in figure 7 - there are no "17"s in figure 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

There is a newly submitted "replacement" sheet on 3-17-04. It is noted that there does not appear to be any changes from the original figure 8

Claim Rejections - 35 USC § 112

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim1-8 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The change to page 5 of the specification appears to change the scope of "optic fiber run." This appears to change the scope to be completely different from what was originally presented. Thus there is no basis for what appears to be the present definition of "optic fiber run".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-8 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to "optic fiber run(s)". This term is indefinite to its meaning. First, examiner could find no definition in the specification. Second, Examiner performed an EAST search on the term. There were no hits. It does not appear to be an art recognized term. Applicant is permitted to be their own lexicographer, but such requires defining what these new terms are. Likewise "optical fiber run(s)" was searched, but the hits were only in the verbal form (e.g. the optical fiber runs from the top to the bottom).

Finally, Examiner tried to figure out from the entire application what is meant by this term. The claim already refers to "optical fiber paths" and "optical fibers". Thus these runs and deemed not to be the paths nor the fibers themselves. The specification indicates that "17" are the optic fiber runs - but each 17 seems to be a fiber in the drawings. Also, page 5, 3rd line from the bottom states there are plural runs in figure 7, however figure 7 does not have any fibers - thus runs are not fibers. It appears that "optic fiber run" is of a scope that it may or may not contain a fiber.

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Claim 1, line 5 refers to "the at least one optic fiber n figure runs having into". Examiner simply cannot understand this. Line 7 refers to "the input group" there is no antecedent basis for a single input group - only for 'at least two input groups'. Line 8 there is not antecedent basis for "the m fibers"; "m" refers to the runs. The last two lines: there is no antecedent basis for "the fiber runs in the input groups" or for "the fiber runs in the output groups"; most notably the fibers are in the output groups, not the runs.

Claim 4 - it is unclear if the ribbonizing is limited to one (or both) of the ribbonizing of claim 1, or if it can also read on any additional ribbonizing.

Claim 6 refers to "computer controlled" but it does not indicate what is computer controlled. There is no antecedent for "the computer optic fiber dispensing head...."

Claim 7, there is confusing antecedent basis for the various "groups".

Claim 8: it is unclear if the conjunction signified by the comma of line 2 is "or", "and" or even something else.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin 5204927.

See the previous Office Action for the manner in which Chin is applied.

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Claim 7 is met by repeating the Chin process the correct number of times. If Examiner understands the claim correctly the correct number of times is 15 (or 30) for the figure 12 embodiment of Chin – and 9 (or 18) for the figure 15 embodiment.

Claim 8: is directed to wrapping the fiber on the template. Chin moves the template rather than the fiber. It would have been an obvious modification to move the fiber rather than the template, because each is just the same relative motion between the two. If one were to wrap the fiber around the drum, the fiber would be going in various directions at different times, and it would be wrapped around the wrapping post.

Response to Arguments

Applicant's arguments filed 02 Jan 2004 have been fully considered but they are not persuasive.

It is argued that the term "optic fiber run" is clearly defined by the specification and drawings. Applicant points to the drawings and paragraph 28 which refers to figure 5 "to define a plurality of optic fiber runs 17". If Applicant wishes to limit the claims to the structure in figure 5, then it must be done by words, not drawings. As pointed out in the MPEP:

Some applications are filed with an omnibus claim which reads as follows: A device substantially as shown and described. This claim should be rejected under 35 U.S.C. 112, second paragraph because it is indefinite in that it fails to point out what is included or excluded by the claim language. See *Ex parte Fressola*, 27 USPQ2d 1608 (Bd. Pat. App. & Inter. 1993), for a discussion of the history of omnibus claims and an explanation of why omnibus claims do not comply with the requirements of 35 U.S.C. 112, second paragraph.

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Applicant is reminded that to act as one's own lexicographer, the specification must clearly set forth an explicit definition, thus Applicant is not acting as lexicographer. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F3d 985, 989 (Fed. Cir.1999). So even if the present specification does have a definition (as Applicant argues) it is neither explicit, nor is it clearly set forth. If there is one, Applicant should point it out by page and line number.

Applicant argues that the specification "clearly define the optic fiber runs as being a length of optic fiber". If this is true, it is neither explicit nor clearly set forth. Moreover, it makes more confusing as to how (multiple) "runs" can be a (single) length.

It is further argued that paragraph 33 "defined" the term. Again, if there is a definition, it is neither explicit nor is it clearly set forth. At most, Examiner sees examples of runs.

It is further argued that the "optic fiber run" is a term of art. First of all, the references that Applicant provided, is directed to fiber connects between building – there is no mention in the present field of small connectors such as what Applicant shows in the drawings. It does not appear that Applicant wishes the claims to be limited to fibers that run for meters and meters. Second, the references do not use the term consistently, namely, the coshoctoncounty reference refers to "digging the entire length of the fiber optic run" – this suggests a pathway, rather than the fiber itself. This is more consistent with the traditional meanings of "run" "a horizontal distance" "a course or trip" a way track or path frequented by animals" "a support (as in a track, pipe or

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trough) on which something runs". And third, the references themselves do not provide a definition for what is meant by the term.

Regarding Chin it is argued that Chin does not have forming more than one group of fibers on either side of the fiber coupler. The relevance of this is not pointed out by Applicant, nor is it understood by Examiner. The claim has no explicit or implicit mentioning of any side. More importantly, when one coupler is made, there is one group on one side. When there is a second coupler, made, there will a second group. Each time another coupler is made, there results another group of fibers. Applicant, makes the runs sequentially, likewise the claims are open to making the groups sequentially. The claims are comprising in nature and are open to making many couplers.

IT is further argued that the forming of a group requires that at least tow optical fibers be gathered together. First of all, there is no step of "forming" any groups. Second there is no mention of any gathering of fibers. Third there doesn't seem to be any implicit requirement for either of these things. Lastly, even if there were, it is unclear what would constitute gathering together. For example, could they be 1 cm apart from each other? 1 mm? 0.01 mm? What if there were a barrier to prevent contact?

It is argued that Chin does not have two input groups and two output groups. The rejection clearly is in agreement with this argument. The rejection also indicates that (and how) such is an obvious modification.

It is further argued that the “m” and “n” fiber runs “results in the manufactured matrix of optical fibers being cross connected. This appears to be true for at least on of Applicant’s disclosed embodiments. However, the claims are not limited to the matrix of Applicant’s disclosure. The matrix is not an inherent feature of the broad claims.

It is further argued (last paragraph page 19) that a particular modification of Chin would result in Chin being unsatisfactory for its intended purpose. The relevance of this argument is not understood. The rejection makes no mention of altering the Chin invention to have two groups “sequentially spaced apart” – nor do the present broad claims require such. It appears Applicant is reading limitations into the claims . Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is further argued that the proposed modification of Chin is improper because the teachings are insufficient to render claim 1 obvious. Chin need not teach repeating the process. Repeating a process to make twice as many couplers is not a patentable invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

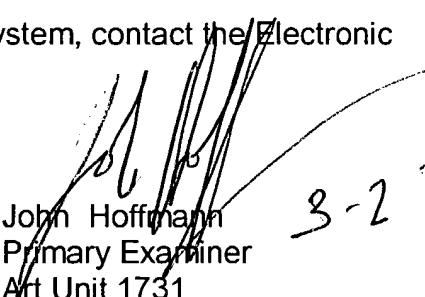
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

3-27-04

jmh